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Notice of Appeal from the Examiner to the Board of Patent Appeals and Interferences (1 sheet)
Appeal Brief Under 37 C.F.R. §41.37 (20 sheets)
Appendix A (2 sheets)
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Signature of Certifier

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PATENT

Application # 09/528,693

Attorney Docket # 2000P07518US (1009-026)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : James Wright et al.
Application # : 09/528,693
Filed : 20 March 2000
Application Title : METHOD, SYSTEM AND APPARATUS FOR PROVIDING
PRODUCT INFORMATION OVER THE INTERNET
Art Unit # : 3627
Latest Examiner : Andrew J. Fischer
Docket No. : 2000P07518US (1009-026)

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF UNDER 37 C.F.R. §41.37

Sir:

The Applicant respectfully submits this Appeal Brief in response to the Notification of Non-Compliant Appeal Brief of 15 September 2005, in substitution of the Reply Brief under 37 C.F.R. §41.41 filed on 29 June 2005 and 3 October 2005, and in response to the Office Action of 4 April 2005 finally rejecting each of the pending claims 1-6, all of which claims have been twice rejected. This Appeal Brief is in furtherance of the Notice of Appeal filed herewith. Applicant respectfully requests that the fees paid with the Notice of Appeal filed on 18 October 2004 and the Appeal Brief filed on 14 December 2004 be applied to the fees due for the attached Notice of Appeal and this Appeal Brief.

PATENT**Application # 09/528,693****Attorney Docket # 2000P07518US (1009-026)****I. REAL PARTY IN INTEREST**

The real party in interest is Siemens Energy & Automation, Inc., a corporation having a place of business at 3333 Old Milton Parkway, Iselin, GA 3005.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

III. STATUS OF CLAIMS

Claims 1-6 are pending in this application and have been finally rejected. Claims 7-20 were cancelled. Claims 1-6 were rejected and are the subject of this appeal. Claim 1 is the independent claim.

IV. STATUS OF AMENDMENTS

No amendments have been filed subsequent to the final rejection.

V. SUMMARY OF CLAIMED SUBJECT MATTER**Independent Claim 1**

Independent Claim 1 recites a system (see at least paragraph 18; Figure 1 indicator 102 and product 106) for providing product information (see at least paragraph 29; Figure 4 product information 404) for a predetermined product (see at least paragraph 18; Figure 1 product 106). The system comprises a product information apparatus (see at least paragraph 18; Figure 1 label 100) comprising an indicator (see at least paragraph 18; Figure 1 indicator 102), wherein the indicator (see at least paragraph 18; Figure 1 indicator 102) is contained in a memory (see at least paragraph 23; Figure 2 memory 200). The system also comprises a predetermined product (see

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at least paragraph 18; Figure 1 product 106), which is coupleable to a programmable logic controller (see at least paragraph 26), wherein the programmable logic controller (see at least paragraph 26) is coupleable to a network (see at least paragraph 26). The indicator (see at least paragraph 18; Figure 1 indicator 102) is associated with a predetermined product (see at least paragraph 18; Figure 1 product 106). The indicator is indicative of a network web page (see at least paragraph 29; Figure 4) where product information (see at least paragraph 29; Figure 4 product information 404) is provided for the predetermined product (see at least Figure 1 product 106). The network web page (see at least paragraph 29; Figure 4) comprises an on-line product support help window (see at least paragraph 29; Figure 4 help window 410).

Dependent Claim 2

To independent Claim 1, Claim 2 adds that the indicator (see at least paragraph 18; Figure 1 indicator 102) is specific to the predetermined product (see at least paragraph 18; Figure 1 product 106), such that a plurality of indicators (see at least paragraph 18; Figure 1 indicator 102) that direct to a plurality of web pages (see at least paragraph 29; Figure 4) are provided, each web page (see at least paragraph 29; Figure 4) providing specific product information (see at least paragraph 29; Figure 4 product information 404) relevant to the predetermined product (see at least paragraph 18; Figure 1 product 106).

Dependent Claim 3

To independent Claim 1, Claim 3 adds that the indicator (see at least paragraph 18; Figure 1 indicator 102) is an URL of a web page (see at least paragraph 18; Figure 1 indicator 102).

Dependent Claim 4

To independent Claim 1, Claim 4 adds that the system further comprises a label (see at least paragraph 18; Figure 1 label 100) affixed to the predetermined product (see at least

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paragraph 18; Figure 1 product 106), wherein the label (see at least paragraph 18; Figure 1 label 100) comprises the memory (see at least paragraph 23; Figure 2 memory 200).

Dependent Claim 5

To independent Claim 1, Claim 5 adds that the memory (see at least paragraph 23; Figure 2 memory 200) is a micro-chip memory (see at least paragraph 24).

Dependent Claim 6

To independent Claim 1, Claim 6 adds that the programmable logic controller (see at least paragraph 26) is coupled to the network (see at least paragraph 26) via means (see at least paragraph 26) for automatically interfacing to the Internet (see at least paragraph 26) to access the web page (see at least paragraph 29; Figure 4) based on the indicator (see at least paragraph 18; Figure 1 indicator 102).

VI GROUND OF REJECTION

Claims 1-6 were rejected as indefinite under 35 U.S.C. §112.

Claims 1-6 were rejected as anticipated under 35 U.S.C. §102(b). In support of the rejection, Cragun (U.S. Patent No. 5,804,803) was applied.

Claims 1-6 were rejected as anticipated under 35 U.S.C. §102(e). In support of the rejection, Reber (U.S. Patent No. 5,940,595) was applied.

Claims 1-6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Cragun in view of Ohanian (U.S. Patent No. 6,109,526).

Claims 1-6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hudetz (U.S. Patent No. 5,978,773) in view of Ohanian.

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The Office Action of 04 April 2005 objects to the specification because "The specification states 'Fig. 2 shows the memory of the present invention.' However a review of figure 2 shows that not only does figure 2 show memory 200, figure 2 also shows processor 202, internet interface 204, and display 206. Thus Applicants statement that figure 2 show 'the memory' is inaccurate. Appropriate correction is required." Applicants respectfully traverse this objection.

According to the Federal Circuit "[i]t is well settled that a patent applicant may be his own lexicographer." *W.L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 316 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Here, the claim term "memory" has been clearly defined in the specification, and that definition must control examination of those claims that recite these terms.

Specifically, independent claim 1 from which each of claims 2-6 depend, recites a "memory". At least page 4 of the Specification defines the term memory by stating "[f]igure 2 shows the memory 200 of the present invention ... While the figure shows that the memory includes supporting devices such as a processor 202 and interface, the memory may be a stand-alone memory."

Thus, the objection of the 04 April 2005 Office Action that "Applicants statement that figure 2 show 'the memory' is inaccurate" is itself inaccurate. Consequently, Applicants respectfully submit that the objection to the specification is without merit and respectfully requests reversal of the objection to the specification.

B. The Rejection of Claims 1-6 Under 35 U.S.C. §112

As an initial matter, Applicants point out that the rejection of claims 1-6 under 35 U.S.C. §112 represents a new ground for rejection first presented in the Office Action dated 04 April

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2005 and not necessitated by any amendment made by Applicants. As such Applicants respectfully note that classifying the Office Action dated 04 April 2005 as “final” is contrary to MPEP §706.07(a), which provides “second or any subsequent actions on the merits shall be final, **except** where the examiner introduces a new ground for rejection that is neither necessitated by applicant’s amendment of the claims....” Applicants recognize and respectfully traverse this utter disregard of USPTO procedure and the resulting due process violations resulting from, *inter alia*, paragraph 40 of the Office Action dated 04 April 2005, which, if Applicant chose to continue prosecution, denies Applicant any right to entry of amendments submitted in response to that “final” Office Action.

The Office Action dated 04 April 2005 recites “[t]he term ‘memory’ in claim 1 is used by the claim to mean ‘a processor, a display, and internet interface.’ One of ordinary skill in the art understands that a ‘memory’ can not contain a processor, a display, and an internet interface.”

Regarding indefiniteness rejections, the Federal Circuit has held that the law is clear that if the claims, read in light of the specification, reasonably apprise those skilled in the art of the use and scope of the invention, and if the language is as precise as the subject matter permits, the claims are definite under Section 112, second paragraph. *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 624, 225 USPQ 634, (Fed. Cir. 1985), *cert. dismissed*, 474 U.S. 976 (1985).

As presented *supra*, at least page 4 of the Specification defines the term memory by stating “[f]igure 2 shows **the memory 200** of the present invention ... While the figure shows that **the memory includes supporting devices such as a processor 202 and interface**, the memory may be a stand-alone memory.”

According to the Federal Circuit “[i]t is well settled that a patent applicant may be his own lexicographer.” *W.L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 316 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Here, the claim term “memory” has been clearly defined in the specification, and that definition must control examination of those claims

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that recite these terms.

No evidence or support whatsoever is presented in the Office Action supporting the baseless conclusory assertion that, despite the clear lexicography in the specification to the contrary, “[o]ne of ordinary skill in the art understands that a ‘memory’ can not contain a processor, a display, and an internet interface.” Moreover, no evidence is presented and no assertion is made in the Office Action that the claims, read in light of the specification would not reasonably apprise those skilled in the art of the use and scope of the invention. Thus, no *prima facie* case has been made that claims 1-6 are indefinite. Accordingly Applicants respectfully request reversal of each rejection of claims 1-6.

C. General Legal Standards for Anticipation and Obviousness

To anticipate expressly, the “invention must have been known to the art in the detail of the claim; that is, all of the elements and limitations of the claim must be shown in a single prior art reference, arranged as in the claim”. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001). The single reference must describe the claimed subject matter “with sufficient clarity and detail to establish that the subject matter existed in the prior art and that its existence was recognized by persons of ordinary skill in the field of the invention”. *Crown Operations Int’l, LTD v. Solutia Inc.*, 289 F.3d 1367, 1375, 62 USPQ2d 1917, 1921 (Fed. Cir. 2002). Moreover, the prior art reference must be sufficient to enable one with ordinary skill in the art to practice the claimed invention. *In re Borst*, 345 F.2d 851, 855, 145 USPQ 554, 557 (C.C.P.A. 1965), *cert. denied*, 382 U.S. 973 (1966); *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1354, 65 USPQ2d 1385, 1416 (Fed. Cir. 2003) (“A claimed invention cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled.”).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to

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combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

D. General Argument Regarding Lexicography

Applicants note that the Office Action dated 04 April 2005 continues to erroneously opine that, *inter alia*, "after receiving express notice of the Examiner's position that lexicography is *not* invoked, Applicants' responses have not point out the 'supposed errors' in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b) (i.e. Applicants did not argue lexicography *was* invoked) ... the Examiner also notes that Applicants have declined the Examiner's express invitation to be their own lexicographer." See Page 8.

Paragraph 19 of the Office Action dated 30 July 2003 first adopted definitions for certain claim terms. Specifically, a definition for "programmable logic device", namely "a logic chip that is programmed by the customer rather than by the manufacturer ... Acronym: PLD", was asserted. Without providing any factual support or reasoning, the defined "programmable logic device" (PLD) was opined to be equivalent to the claim term "programmable logic controller".

In the Reply to that Office Action filed on 23 September 2003, the adopted definitions, and particularly the determination that a "programmable logic controller is a PLD", were traversed as factually erroneous. That traverse stands.

The Federal Circuit has held that a "technical term used in a patent document is interpreted as having the meaning that it would be given by persons experienced in the field of the invention, unless it is apparent from the patent and the prosecution history that the inventor used the term with a different meaning." *Hoechst Celanese Corp. v. BP Chems. Ltd.*, 78 F.3d 1575, 1578, 38 USPQ2d 1126, 1129 (Fed. Cir. 1996).

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The definition adopted in the 30 July 2003 Office Action for "programmable logic controller" is erroneous since that definition does not have the meaning that it would be given by persons experienced in the field on the date on the filing date of the present application, 20 March 2000. During examination, no evidence was provided whatsoever supporting the definition of "programmable logic controller" used in the 30 July 2003 Office Action.

In traversing this definition, a first Declaration was filed under 37 CFR § 1.132. This first Declaration was authored and signed by Dr. Ronald D. Williams on 28 February 2004, was entered into the file wrapper on 3 March 2004, and was acknowledged and discussed by the Examiner on page 11 of the Final Office Action dated 18 May 2004.

As indicated in paragraphs 1-6 of the first Declaration, Dr. Williams was one skilled in the art of electrical engineering as of 20 March 2000, the filing date of the application under appeal. Paragraphs 10-11 of the first Declaration of Dr. Williams indicate that the definition used by the examiner is improper because "one skilled in the art would not interpret the term programmable logic controller (PLC) to mean 'A logic chip that is programmed by the customer rather than by the manufacturer'." In paragraph 12 of the first Declaration, Dr. Williams states "one skilled in the art would interpret the term 'programmable logic controller' to mean a device that follows programmed instructions to provide automated monitoring and/or control functions over a machine and/or process by evaluating a set of inputs. A PLC can be used, for example, to automate complex functions and/or control an industrial process, for example, in machining, packaging, materials handling, and/or other applications."

In response to Dr. Williams first Declaration, the Final Office Action dated 18 May 2004 stated:

"[t]he Williams Declaration does not address the scope of claim interpretation during ex parte examination. Although the Williams Declaration states the Examiner's definition is incorrect, the Williams Declaration fails to state why the Examiner's definitions are not proper in this context. Moreover, not only does the Williams Declaration fail to provide

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objective evidence as to why the Examiner's definitions are improper, the Williams Declaration fails to provide evidence as to why Dr. William's definition should be controlling."

As an initial matter, without a showing otherwise, the Williams Declaration is objective evidence. Because Dr. Williams is one of ordinary skill in the art, and because Dr. Williams' definition is the only supported definition of record that addresses the actual claim term "programmable logic controller", the definition of Dr. Williams must be controlling.

Nevertheless, responsive to the assertions in Final Office Action dated 18 May 2004 and the implicit request for additional evidence supporting Dr. Williams' first Declaration, a second Declaration was executed by Dr. Williams on 4 August 2004. The second declaration was entered into the file wrapper on 6 August 2004 and discussed by the Examiner in an Advisory Action dated 8 October 2004. The Office Action dated 04 April 2005 formally acknowledged the previous entry of the second declaration in the record for consideration during the appeal process.

Paragraphs 11-15 of the second Declaration of Dr. Williams clearly explain why the definition for "programmable logic controller" adopted in the 30 July 2003 Office Action is factually incorrect. Paragraphs 17 and 18 provide objective evidence for an additional proper definition of "programmable logic controller" as "a digitally operating electronic apparatus which uses a programmable memory for the internal storage of instructions for implementing specific functions such as logic, sequencing, timing, counting and arithmetic to control through digital or analog input/output modules, various types of machines or processes". In support of this definition, in paragraph 18 Dr. Williams cited NEMA Standard ICS 3-1978, Part ICS3-304 (5). Paragraphs 19 and 20 of Dr. Williams' second Declaration explicitly explain that Dr. Williams' definitions should be controlling because the definition provided in the Office Action dated 30 July 2003 "does not reflect the meaning of 'programmable logic controller' as understood by one skilled in the art."

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Because each of Dr. Williams' definitions for "programmable logic controller" have "the meaning that it would be given by persons experienced in the field of the invention", Dr. Williams' definitions control in claim construction. Utilizing a definition that is unrecognized by those of skill in the art, such as that presented in the Office Actions, would be illogical, counter-productive, and contrary to law.

Yet despite the submission of 2 expert Declarations addressing the proper lexicographical meaning of the claim term "programmable logic controller" and the erroneous definitions assigned to that term in 3 separate Office Actions, the Office Action dated 04 April 2005 still opines that "Applicants' responses have not point out the 'supposed errors' in the examiners position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b) (i.e. Applicants did not argue lexicography was invoked) ... the Examiner also notes that Applicants have declined the Examiner's express invitation to be their own lexicographer."

Applicants further note the general discourse regarding lexicography in the Office Action dated 04 April 2005, as with similar discourses in each previous Office Actions related to Application 09/528,693, fails to present any objection to or rejection of any claim whatsoever.

However, under 37 C.F.R. 111(b) a response must only "reply to every ground of objection and rejection in the prior Office action." General discussions regarding collateral matters, such as lexicography, that do not present either an objection to or rejection of a claim do not require, nor do they necessarily merit, a detailed response. Any attempt to place legally impermissible and prospective restrictions on Applicants' due process rights regarding lexicography in the Office Action dated 4 April 2005 is respectfully traversed. In particular, Applicants traverse any attempt to construe silence regarding a collateral matter as an admission under 37 C.F.R. §1.104(c)(3), when in fact no response is legally required. While prosecution is open and prior to the issuance of Application 09/528,693, Applicants respectfully reserve the right to "be their own lexicographer" at any time with regard to any past, present, and/or future claim language pertaining to that application.

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In light of the above discussion, Applicants respectfully submit that:

1. Absolutely no evidence has been presented to support the definition presented in the Office Actions for “programmable logic controller”;
2. the erroneous definition for the term “programmable logic controller” was properly traversed in Applicants’ Replies dated 23 September 2003, 3 March 2004, and 6 August 2004;
3. Applicants have repeatedly pointed why the definition of the term “programmable logic controller” proffered in the Office Actions is erroneous and Applicants have repeatedly provided substantial and persuasive evidence proving that fact;
4. Applicants have clearly invoked lexicography in both of Dr. Williams’ declarations; and
5. persuasive objective evidence has been presented supporting the definition of a “programmable logic controller” as a “digitally operating electronic apparatus which uses a programmable memory for the internal storage of instructions for implementing specific functions such as logic, sequencing, timing, counting and arithmetic to control through digital or analog input/output modules, various types of machines or processes.” See Dr. Williams’ second declaration, paragraph 17.

E. The Rejection of Claims 1-6 Under 35 U.S.C. §102(b) in View of Cragun**1. Independent Claim 1**

Independent claim 1 recites “an indicator contained in a memory”. Cragun allegedly recites “[i]n the preferred embodiment, scanning device 118 is a laser scanning bar code reader and code 117 is a bar code.” See col. 4, lines 8-9. Cragun does not disclose explicitly or inherently “an indicator contained in a memory”.

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Independent claim 1 recites “the network web page comprising **an on-line product support help window**”. Cragun does not disclose explicitly or inherently “the network web page comprising **an on-line product support help window**”.

Independent claim 1 recites a “predetermined product coupleable to a **programmable logic controller**, the programmable logic controller coupleable to a network”. Cragun allegedly recites a “**client computer** [that] scans the object of interest and translates the code into a URL that specifies both the server computer and the location within the server of information that is relevant to the object”. See col. 2, lines 12-16.

Paragraphs 18-21 of Dr. Williams’ first Declaration provide evidence that one skilled in the art would find that Cragun does not disclose explicitly or inherently a “predetermined product coupleable to a **programmable logic controller**”. Further, Cragun does not disclose explicitly or inherently “said indicator associated with said predetermined product and indicative of a network web page where product information is provided for said predetermined product, the network web page comprising an on-line product support help window.”

Moreover, Cragun fails to properly establish inherent anticipation. See MPEP 2112. “Inherent anticipation requires that the missing descriptive material is ‘necessarily present,’ not merely probably or possibly present, in the prior art.” *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002). No evidence has been presented that admittedly the “missing descriptive material is ‘necessarily present’” in Cragun.

Applicants acknowledge that the Office Action 04 April 2005 recites “[t]he examiner notes that the case cited by Applicants for inherency (i.e. *Trintec Indus., Inc. v. Top-U.S.A. Corp.*) involves inter partes litigation-not ex parte examination. Because the standards for claim interpretation between inter partes litigation and ex parte examination are different, Applicants’ point is not persuasive.” Applicants respectfully traverse this assertion.

Regarding ex parte examination, the Federal Circuit applies a standard equivalent to that

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from *Trintec Indus., Inc. v. Top-U.S.A. Corp*, *supra*. For example, in a case dealing specifically with ex parte examination and specifically cited for the identical proposition by *Trintec*, the Federal Circuit held that to “establish inherency, the extrinsic evidence ‘must make clear **that the missing descriptive matter is necessarily present** in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.’” *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999) (quoting *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed Cir. 1991)) (emphasis added); see also MPEP § 2112.

Thus, Applicants respectfully submit that the assertion that, with respect to this issue, “the standards for claim interpretation between inter partes litigation and ex parte examination are different” is legally erroneous.

Accordingly, it is respectfully submitted that Cragun does not anticipate independent claim 1 either expressly or inherently. Furthermore, because independent claim 1 is not anticipated, it stands that claims 2-6, each ultimately depending from claim 1, are also not anticipated by Cragun.

Consequently, reversal of the rejection of claims 1-6 is respectfully requested.

2. Dependent Claim 4

Dependent claim 4 recites “a label affixed to the predetermined product, wherein said label comprises said **memory**”. Cragun allegedly recites “[i]n the preferred embodiment, scanning device 118 is a laser scanning bar code reader and code 117 is a **bar code**.” See col. 4, lines 8-9. Cragun does not disclose explicitly or inherently “a label affixed to the predetermined product, wherein said label comprises said **memory**”. Accordingly, it is respectfully submitted that Cragun does not anticipate dependent claim 6.

Consequently, reversal of the rejection of claim 4 is respectfully requested.

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3. Dependent Claim 5

Dependent claim 5 recites “wherein said memory is a **micro-chip memory**”. Cragun does not disclose explicitly or inherently “wherein said memory is a micro-chip memory”. Instead, Cragun allegedly recites “[i]n the preferred embodiment, scanning device 118 is a laser scanning bar code reader and **code 117 is a bar code.**” Accordingly, it is respectfully submitted that Cragun does not anticipate dependent claim 5.

Consequently, reversal of the rejection of claim 5 is respectfully requested.

F. The Rejection of Claims 1-6 Under 35 U.S.C. §102(e) in View of Reber

Claim 1, upon which claims 2-5 depend, cites “a predetermined product coupleable to a **programmable logic controller**, the programmable logic controller coupleable to a network, said indicator associated with said predetermined product and indicative of a network web page where product information is provided for said predetermined product, the network web page comprising an **on-line product support help window.**”

Paragraphs 18-21 of Dr. Williams’ first Declaration, and paragraphs 21-24 of Dr. Williams’ second Declaration, each provide evidence that one skilled in the art would find that Reber does not disclose explicitly or “a predetermined product coupleable to a **programmable logic controller**, the programmable logic controller coupleable to a network”.

Further, Reber does not disclose explicitly an “said indicator associated with said predetermined product and indicative of a network web page where product information is provided for said predetermined product, the network web page comprising an **on-line product support help window.**”

While purporting to reject claims 1-6 under 35 U.S.C. §102(e) in view of Reber, the Office Action dated 04 April 2005, particularly paragraph 35, fails to establish a *prima facie* rejection by failing to show that Reber expressly or inherently teaches all of the limitations of claims 1-6. Specifically, paragraph 35 of the Office Action dated 04 April 2005 admits that Reber does not

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expressly disclose "the network web page comprising an on-line product support help window."

Moreover, Reber fails to properly establish inherent anticipation. See MPEP 2112.

"Inherent anticipation requires that the missing descriptive material is 'necessarily present,' not merely probably or possibly present, in the prior art." *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002). No evidence has been presented that admittedly the "missing descriptive material is 'necessarily present'" in Reber.

Accordingly, it is respectfully submitted that Reber does not anticipate independent claim 1. Furthermore, because independent claim 1 is not anticipated, it stands that claims 2-6, each ultimately depending from claim 1, are also not anticipated by Reber.

Consequently, reversal of the rejection of claims 1-6 is respectfully requested.

G. The Rejection of Claims 1-6 Under 35 U.S.C. §103(a) in View of Cragun and Ohanian

None of the applied references, either alone or in any combination, establish a *prima facie* case of obviousness.

Ohanian allegedly recites "the present invention embodies a data input apparatus that obtains information relative to a target. The apparatus includes a processor, a wireless data receiver, and an associated data capture engine. The wireless data receiver is coupled to the processor and receives electromagnetic data from at least one resonator, such as a dipole, positioned relative to the target. The data capture engine is also coupled to the processor and receives data from an associated data carrier, such as a machine-readable symbol..." See column 2 lines 10-19.

Paragraphs 18-25 of Dr. Williams' first Declaration, and paragraphs 25-28 of Dr. Williams' second declaration, each provide evidence that one skilled in the art would find that Neither Cragun nor Ohanian expressly or inherently teach or suggest "...a predetermined product coupleable to a **programmable logic controller**, the programmable logic controller coupleable to

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a network, said indicator associated with said predetermined product and indicative of a network web page where product information is provided for said predetermined product, the network web page comprising **an on-line product support help window.**" Thus, even if combinable or modifiable, the applied references do not expressly or inherently teach or suggest every limitation of the claims.

Further, attempting to combine Cragun with Ohanian would render one or the other inoperative. For example, attempting to replace Cragun's "scanning device" (see Fig. 1A element 118) with Ohanian's "wireless data receiver" (see col.2, lines 14-15) would render Cragun's system inoperative for its intended function of scanning barcodes.

Thus, there would have been no motivation or suggestion to modify or combine the applied references, and one skilled in the art would not have had a reasonable expectation of success in combining or modify the applied references. In addition, the applied references do not expressly or inherently teach or suggest every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness.

Accordingly, it is respectfully submitted that Cragun in view of Ohanian does not render obvious independent claim 1. Furthermore, because independent claim 1 is not rendered obvious by either applied combination, it stands that claims 2-6, each ultimately depending from claim 1, are also not rendered obvious by Cragun in view of Ohanian.

Consequently, reversal of the rejection of claims 1-6 is respectfully requested.

H. The Rejection of Claims 1-6 Under 35 U.S.C. §103(a) in View of Ohanian and Hudetz

Hudetz allegedly cites "[a] system and method for using identification codes found on ordinary articles of commerce to access remote computers on a network. In accordance with one embodiment of the invention, a **computer** is provided having a database that relates Uniform Product Code ('UPC') numbers to Internet network addresses (or 'URLs'). To access an Internet resource relating to a particular product, a user enters the product's UPC symbol manually, by swiping a bar code reader over the UPC symbol, or via other suitable input means.

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The database retrieves the URL corresponding to the UPC code. This location information is then used to access the desired resource.” See Abstract.

Paragraphs 22-29 of Dr. Williams’ first Declaration, and paragraphs 25-31 of Dr. Williams’ second Declaration, each provide evidence that one skilled in the art would find that Neither Ohanian nor Hudetz expressly or inherently teach or suggest “an indicator contained in a memory ... a predetermined product coupleable to a programmable logic controller, the programmable logic controller coupleable to a network.”

Further, attempting to combine Hudetz with Ohanian would render one or the other inoperative. For example, attempting to replace Hudetz’ “bar code reader” (see col. 3, line 32) with Ohanian’s “wireless data receiver” (see col.2, lines 14-15) would render Hudetz’ system inoperative for its intended function of scanning barcodes.

Thus, would have been no motivation or suggestion to modify or combine the applied references, and one skilled in the art would not have had a reasonable expectation of success in combining or modify the applied references. In addition, the applied references do not expressly or inherently teach or suggest every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness.

Accordingly, it is respectfully submitted that Ohanian in view of Hudetz does not render obvious independent claim 1. Furthermore, because independent claim 1 is not rendered obvious by either applied combination, it stands that claims 2-6, each ultimately depending from claim 1, are also not rendered obvious by Ohanian in view of Hudetz.

Consequently, reversal of the rejection of claims 1-6 is respectfully requested.

VIII CLAIMS APPENDIX

Appendix A sets forth all pending claims in the state in which they were appealed.

IX EVIDENCE APPENDICES

The first Declaration of Dr. Ronald D. Williams, filed herewith as Appendix B, was

PATENT**Application # 09/528,693****Attorney Docket # 2000P07518US (1009-026)**

submitted pursuant to 37 CFR 1.132, and was entered into the record by at least the Office Action dated 18 May 2004. The second Declaration of Dr. Ronald D. Williams, filed herewith as Appendix C, was submitted pursuant to 37 CFR 1.132, and was entered into the file wrapper on 6 August 2004 and discussed by the Examiner in an Advisory Action dated 8 October 2004. The Office Action dated 04 April 2005, at page 10, formally acknowledged the previous entry of the second Dr. Williams declaration in the record.

X. RELATED PROCEEDINGS APPENDIX

There are no related proceedings.

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SUMMARY

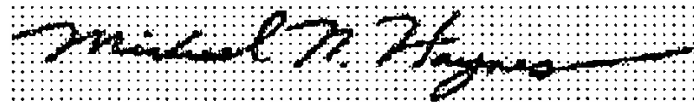
In view of the above, Applicants submit that all claims on appeal distinguish over the applied art and respectfully request that the rejections of these claims should be reversed.

Applicants therefore respectfully request that the Board of Patent Appeals and Interferences reverse the decision rejecting claims 1-6 and direct that the application be passed to issue.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. §1.16 or §1.17 to Deposit Account No. 19-2179. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

Michael Haynes PLC



Date: 19 October 2005

Michael N. Haynes
Registration No. 40,014

1341 Huntersfield Close
Keswick, VA 22947
Telephone: 434-972-9988
Facsimile: 815-550-8850

PATENT**Application # 09/528,693****Attorney Docket # 2000P07518US (1009-026)****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s) : James Wright et al.
Application # : 09/528,693
Filed : 20 March 2000
Application Title : METHOD, SYSTEM AND APPARATUS FOR PROVIDING
PRODUCT INFORMATION OVER THE INTERNET
Art Unit # : 3627
Latest Examiner : Andrew J. Fischer
Docket No. : 2000P07518US (1009-026)

Mail Stop Appeal Brief-Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

APPENDIX A

1. A system for providing product information for a predetermined product comprising:
a product information apparatus comprising an indicator contained in a memory; and
a predetermined product coupleable to a programmable logic controller, the programmable logic controller coupleable to a network, said indicator associated with said predetermined product and indicative of a network web page where product information is provided for said predetermined product, the network web page comprising an on-line product support help window.
2. The system of claim 1, wherein said indicator is specific to said predetermined product, such that a plurality of indicators that direct to a plurality of web pages are provided, each web page providing specific product information relevant to said predetermined product.
3. The system of claim 1, wherein said indicator is an URL of a web page.

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4. The system of claim 1, further comprising a label affixed to the predetermined product, wherein said label comprises said memory.

5. The system of claim 1, wherein said memory is a micro-chip memory.

6. The system of claim 5, wherein the programmable logic controller is coupled to the network via means for automatically interfacing to the Internet to access said web page based on said indicator.

7. – 20. (canceled).

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PATENT

Serial No. 09/528,693

Attorney Docket No. 2000P07518US (1009-026)

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Applicant(s) : James Wright et al.
Serial No. : 09/528,693
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APPENDIX B

Filed herewith is a copy of the first Declaration of Dr. Ronald D. Williams that was
submitted pursuant to 37 CFR 1.132.

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**AMENDMENT UNDER 37 C.F.R. 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 3627
PATENT**

**ATTORNEY DOCKET NO. 2000P7518 US (1009-026)
SERIAL NO. 09/528,693**

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Serial No. 09/528,693
Applicant James Wright et al.
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Title METHOD, SYSTEM AND APPARATUS FOR PROVIDING
PRODUCT INFORMATION OVER THE INTERNET
Art Unit 3627
Examiner Andrew J. Fischer

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

DECLARATION UNDER 37 C.F.R. § 1.132

Sir:

I, Dr. Ronald D. Williams, a citizen of the United States, whose full post office address is 1715 Hearthglow Lane, Charlottesville, VA 22901 declare as follows under penalty of perjury.

1. I hold a Ph.D. degree in Electrical Engineering from the Massachusetts Institute of Technology awarded in 1984.
2. I hold a M.S. degree in Electrical Engineering from the University of Virginia awarded in 1978.
3. I hold a B.S. degree in Electrical Engineering from the University of Virginia awarded in 1977.

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PATENT**

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SERIAL NO. 09/528,693**

4. I am currently an associate professor of Electrical & Computer Engineering at the University of Virginia.
5. Since 1984, I have worked continually in the field of electrical engineering with particular emphasis in embedded computing with applications in control and signal processing.
6. During my career, I have been granted five U.S. patents for my own inventions in the field of embedded computing.
7. I have reviewed Application Serial No. 09/528,693.
8. I have reviewed U.S. Patents Nos. 5,804,803 (Cragun '803); 5,940,595 (Reber '595); 6,109,526 (Ohanian '526); and 5,978,773 (Hudetz '773).
9. Among the devices with which I was familiar prior to 03/20/2000, the filing date of Application Serial No. 09/528,693, were devices of the type recited in Cragun '803, Reber '595, Ohanian '526, and Hudetz '773.
10. I have reviewed the U.S. Patent Office Action dated 30 July 2003 ("Office Action 1") in Application Serial No. 09/528,693, which contains the following statement: "the Examiner hereby adopts the following definitions as the broadest reasonable interpretation in all his claim interpretations ... b. Controller 'A device on which other devices rely for access to a computer subsystem' ... e. Programmable logic device 'A logic chip that is programmed by the customer rather than by the

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manufacturer' ... a programmable logic controller is a PLD."

11. From the view of one skilled in the electrical engineering art as of 20 March 2000, the filing date of Application Serial No. 09/528,693, the definitions adopted in Official Action 1 are factually incorrect. Specifically, one skilled in the art would not interpret the term "programmable logic controller (PLC)" to mean 'A logic chip that is programmed by the customer rather than by the manufacturer'.
12. Instead, one skilled in the art would interpret the term "programmable logic controller (PLC)" to mean a device that follows programmed instructions to provide automated monitoring and/or control functions over a machine and/or process by evaluating a set of inputs. A PLC can be used, for example, to automate complex functions and/or control an industrial process, for example, in machining, packaging, materials handling, and/or other applications.
13. I have reviewed the U.S. Patent Office Action dated 17 December 2003 ("Office Action 2") in Application Serial No. 09/528,693, which contains the following statement: "it is unclear what structural elements make up the 'automatically interfacing to the Internet to access said web page based on said indicator.'"
14. That statement is factually incorrect, in view of the state of the electrical engineering art as of 03/20/2000, the filing date of Application Serial No. 09/528,693. One skilled in the art would not find that "it is unclear what structural elements make up

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the 'automatically interfacing to the Internet to access said web page based on said indicator.'"

15. Rather, one skilled in the art would find ample and clearly linked corresponding structure for the recited function of claim 6. Specifically, page 4 of the specification recites "an Internet interface 204 for automatically interfacing to the internet using the label retrieved from the memory 200"; "the interface is provided by a human/machine interface (HMI) such as that provided by Siemens"; "[t]he HMI provides a software interface to industrial-type processors such as PLCs"; and "an internet interface is provided that automatically interfaces to the internet using the label stored in memory 200".
16. As of 20 March 2000, one skilled in the art would recognize that these recited "interfaces" explicitly recite "software", which one skilled in the art would recognize to run on and/or utilize known hardware.
17. Thus, one skilled in the art would recognize that these recited structures are adequate for enabling the recited function of claim 6, and clearly linked to the recited function of claim 6.
18. I have reviewed U.S. Patent Office Action 2 in Application Serial No. 09/528,693, which contains the following statement: "Cragun '803 discloses ... alternatively ... Reber '595 discloses ... the RF device contains a PLC since the RF device is an

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‘active’ RF device and the RF device is coupleable to the product.”

19. That statement is factually incorrect, in view of the state of the electrical engineering art as of 03/20/2000, the filing date of Application Serial No. 09/528,693. One skilled in the art would not find that “Cragun ‘803 discloses ... alternatively ... Reber ‘595 discloses ... the RF device contains a PLC since the RF device is an ‘active’ RF device and the RF device is coupleable to the product.”
20. Rather, one skilled in the art would interpret the term “PLC” to mean a programmable logic controller as defined in paragraph 12.
21. Accordingly, one skilled in the art would not find that “Cragun ‘803 discloses ... alternatively ... Reber ‘595 discloses ... the RF device contains a PLC since the RF device is an ‘active’ RF device and the RF device is coupleable to the product.”
22. I have reviewed U.S. Patent Office Action 2 in Application Serial No. 09/528,693, which contains the following statement: “the claims are anticipated because of the inherent features (i.e. the old and well known structure and features of RF tags). However if not inherent, Ohanian directly teaches the use of RF tags in replace bar codes because, inter alia, bar codes may be obscured.”
23. That statement is factually incorrect, in view of the state of the electrical engineering art as of 03/20/2000, the filing date of Application Serial No. 09/528,693. One skilled in the art would not find that “the claims are anticipated because of the

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inherent features (i.e. the old and well known structure and features of RF tags).

However if not inherent, Ohanian directly teaches the use of RF tags in replace bar codes because, inter alia, bar codes may be obscured."

24. Rather, one skilled in the art would interpret the term "PLC" to mean a programmable logic controller as defined in paragraph 12.

25. Accordingly, one skilled in the art would not find that "the claims are anticipated because of the inherent features (i.e. the old and well known structure and features of RF tags). However if not inherent, Ohanian directly teaches the use of RF tags in replace bar codes because, inter alia, bar codes may be obscured."

26. I have reviewed U.S. Patent Office Action 2 in Application Serial No. 09/528,693, which contains the following statement: "Hudz directly or inherently discloses all the claimed features except it uses bar codes because, inter alia, bar codes may be obscured."

27. That statement is factually incorrect, in view of the state of the electrical engineering art as of 03/20/2000, the filing date of Application Serial No. 09/528,693. One skilled in the art would not find that "Hudz directly or inherently discloses all the claimed features except it uses bar codes because, inter alia, bar codes may be obscured."

28. Rather, one skilled in the art would interpret the term "PLC" to mean a programmable

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logic controller as defined in paragraph 12.

29. Accordingly, one skilled in the art would not find that "Hudz directly or inherently discloses all the claimed features except it uses bar codes because, inter alia, bar codes may be obscured."

I further declare that all statements made herein of my own knowledge are true and that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code and that willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Signed this 28th day of February 2004



Dr. Ronald D. Williams

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Serial No. 09/528,693

Attorney Docket No. 2000P07518US (1009-026)

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APPENDIX C

Filed herewith is a copy of the second Declaration of Dr. Ronald D. Williams that was submitted pursuant to 37 CFR 1.132.

**AMENDMENT UNDER 37 C.F.R. 1.116
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Examiner Andrew J. Fischer

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DECLARATION UNDER 37 C.F.R. § 1.132

Sir:

I, Dr. Ronald D. Williams, a citizen of the United States, whose full post office address is 1715 Hearthglow Lane, Charlottesville, VA 22901 declare as follows under penalty of perjury.

1. I hold a Ph.D. degree in Electrical Engineering from the Massachusetts Institute of Technology awarded in 1984.
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4. I am currently an associate professor of Electrical & Computer Engineering at the University of Virginia.
5. Since 1984, I have worked continually in the field of electrical engineering with particular emphasis in embedded computing with applications in control and signal processing.
6. During my career, I have been granted five U.S. patents for my own inventions in the field of embedded computing.
7. I have reviewed Application Serial No. 09/528,693.
8. I have reviewed U.S. Patents Nos. 5,804,803 (Cragun '803); 5,940,595 (Reber '595); 6,109,526 (Ohanian '526); and 5,978,773 (Hudetz '773).
9. Among the devices with which I was familiar prior to 03/20/2000, the filing date of Application Serial No. 09/528,693, were devices of the type recited in Cragun '803, Reber '595, Ohanian '526, and Hudetz '773.
10. Regarding Application Serial No. 09/528,693, I have reviewed the U.S. Patent Office Action dated 30 July 2003 ("Office Action 1") and the U.S. Patent Office Action dated 18 May 2004 ("Office Action 2").
11. Office Action 1 contains, and Office Action 2 implicitly references, the following statement: "the Examiner hereby adopts the following definitions as the broadest reasonable interpretation in all his claim interpretations ... b. Controller 'A device on

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which other devices rely for access to a computer subsystem' ... e. Programmable logic device 'A logic chip that is programmed by the customer rather than by the manufacturer'. It is the Examiner [sic] factual determination that a programmable logic controller is a PLD."

12. The Office Action provides no reason, factual or otherwise, for why "the Examiner" equated a "programmable logic controller" with a "PLD".
13. The Office Action provides no showing that one skilled in the art would equate a "programmable logic controller" with a "PLD".
14. From the view of one skilled in the electrical engineering art as of 20 March 2000, the filing date of Application Serial No. 09/528,693, the definition of a "programmable logic controller" adopted in Official Action 1, and implicitly referenced by Office Action 2, is factually incorrect.
15. Specifically, one skilled in the art would not interpret the term "programmable logic controller (PLC)" to mean "[a] logic chip that is programmed by the customer rather than by the manufacturer".
16. Instead, one skilled in the art would interpret the term "programmable logic controller (PLC)" to mean a device that follows programmed instructions to provide automated monitoring and/or control functions over a machine and/or process by evaluating a set of inputs. A PLC can be used, for example, to automate complex functions and/or

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control an industrial process, for example, in machining, packaging, materials handling, and/or other applications.

17. Alternatively, one skilled in the art would interpret the term “programmable logic controller (PLC)” to mean “a digitally operating electronic apparatus which uses a programmable memory for the internal storage of instructions for implementing specific functions such as logic, sequencing, timing, counting and arithmetic to control through digital or analog input/output modules, various types of machines or processes”.
18. For evidence supporting these definitions, one skilled in the art would have looked to a standard setting body such as the National Electrical Manufacturers Association (NEMA). NEMA defines a programmable logic controller as “a digitally operating electronic apparatus which uses a programmable memory for the internal storage of instructions for implementing specific functions such as logic, sequencing, timing, counting and arithmetic to control through digital or analog input/output modules, various types of machines or processes”. See NEMA Standard ICS 3-1978, Part ICS3-304(5) (relevant pages attached hereto).
19. Office Action 2 contains the following statement: “[a]lthough the Williams Declaration states the Examiner’s definition is incorrect, the Williams Declaration fails to state why the Examiner’s definitions are not proper in this context. Moreover,

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not only does the Williams Declaration fail to provide objective evidence as to why the Examiner's definitions are improper, the Williams Declaration fails to provide evidence as to why Dr. Williams definitions should be controlling".

20. One skilled in the art would find that the definition provided for "programmable logic controller" in Office Action 1 is improper because it does not reflect the meaning of "programmable logic controller" as understood by one skilled in the art.
21. The facts of paragraphs 1 through 6 reasonably indicate that I am skilled in the art pertaining to Application 09/528,693 and have been since at least 1984.
22. I have reviewed U.S. Patent Office Action 2 in Application Serial No. 09/528,693, which contains the following statement: "Reber '595 discloses ... a PLC'"
23. That statement is factually incorrect, in view of the state of the electrical engineering art as of 03/20/2000, the filing date of Application Serial No. 09/528,693.
24. Based on the definitions of a programmable logic controller provided in either paragraph 16 or 17, one skilled in the art would not find that "Reber '595 discloses ... a PLC" whatsoever.
25. I have reviewed U.S. Patent Office Action 2 in Application Serial No. 09/528,693, which contains the following statement: "Ohanian directly teaches the use of RF tags (a PLC) in replace of bar codes".
26. That statement is factually incorrect, in view of the state of the electrical engineering

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art as of 03/20/2000, the filing date of Application Serial No. 09/528,693.

27. Based on the definitions of a programmable logic controller provided in either paragraph 16 or 17, one skilled in the art would not equate Ohanian's "RF tags" to a "PLC".
28. Accordingly, one skilled in the art would not find that "Ohanian directly teaches the use of RF tags (a PLC) in replace of bar codes".
29. I have reviewed U.S. Patent Office Action 2 in Application Serial No. 09/528,693, which contains the following statement: "Hudz directly or inherently discloses all the claimed features", implying that Hudetz discloses a "programmable logic controller".
30. That statement and implication is factually incorrect, in view of the state of the electrical engineering art as of 03/20/2000, the filing date of Application Serial No. 09/528,693.
31. Based on the definitions of a programmable logic controller provided in either paragraph 16 or 17, one skilled in the art would not find that "Hudz directly or inherently discloses all the claimed features" or a "programmable logic controller" whatsoever.

I further declare that all statements made herein of my own knowledge are true and that these statements were made with the knowledge that willful false statements and the like so made are

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punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code and that willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Signed this 4th day of August 2004


Dr. Ronald D. Williams